

DETAILED ACTION

The Final Rejection is withdrawn; prosecution is reopened.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2, 6, 15-16 rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the solvates prepared, does not reasonably provide enablement for other solvents. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

Certain alcohols form solvates. However, judging from table A, many solvents do not form solvates, at least not according to the methods that applicants use. Thus, e.g. experiment 1 failed to form either an ethyl acetate solvate or a diethyl ether solvate. Example 7 failed to produce a methanol solvate, example 11 failed to produce a dioxane solvate, example 10 failed to produce an ethanol solvate, example 2 failed to produce an acetone solvate, etc. Therefore the scope of claim 1 or even scope of claim 2 cannot be deemed enabled.

Claim 17-19 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the compound or crystal, does not reasonably provide enablement for the solvate. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

Applicants have shown that the esters form solvates, at least with some alcohols. However, applicants have not shown that Formula II, which is an acid, forms a solvate, or even the hydrate of claim 19.

Claim Objections

Claims 3-5, 7-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Mark L. Berch/ whose telephone number is 571-272-0663. The examiner can normally be reached on M-F 7:15 - 3:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on (571)272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark L. Berch/

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Primary Examiner
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